



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/583,820

06/21/2006

Franklin Selgert

03-1111-B

8743

20306

7590

01/19/2011

MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

EXAMINER

KELLY, RAFFERTY D

ART UNIT

PAPER NUMBER

2876

MAIL DATE

DELIVERY MODE

01/19/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/583,820	Applicant(s) SELGERT, FRANKLIN	
	Examiner RAFFERTY KELLY	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,7-9,11-13,16-20 and 22-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,7-9,11-13,16-20 and 22-28 is/are rejected.
- 7) ☒ Claim(s) 29-31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20100830</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination and amendment filed on 8/30/10 has been acknowledged and entered.

Claim Objections

Claims 29, 30, and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Allowable Subject Matter

Claims 29-31 are allowable.

The following is a statement of reasons for the indication of allowable subject matter: the prior art fails to teach all of the features of claims 29-31. Specifically the prior art does not teach that the RF signal transmitted from the RF chip comprises a link to information associated with a product to which the RF chip is attached.

Pond et al. (US 2004/0030601 A1) teaches the features of claims 1, 7, and 18, as discussed below. However, the information that is being transmitted in Pond relates to transaction information (price totals, account number, transaction verification, etc.). Pond does not teach transmitting a link to product information as discussed in claims 29-31.

Chauvin et al. (US 2002/0030606 A1) also teaches a number of features of claims 1, 7, and 18 (See office action dated 3/10/10. However, Chauvin teaches transmitting information relating to parking and parking meter transactions. Chauvin

Art Unit: 2876

does not teach transmitting a link to information associated with a product to which the RF chip is attached.

None of the cited references, or any other references, teaches all of the features of claims 29-31. Further, it would not have been obvious to one of ordinary skill in the art at the time of invention to combine any references to arrive at the teachings of claims 29-31. Therefore, these claims are found to be allowable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 7, 8, 11-13, 17-19, and 22-28 rejected under 35 U.S.C. 102(e) as being anticipated by Pond et al. (US 2004/0030601 A1).

Regarding claims 1 and 12, Pond teaches a system comprising: a customer device (104) configured to receive an RF signal from an RF chip via a first communication path (530), and responsively (i) start communicating with a communication network via a second separate communication path (internet - 1409) and (ii) send an enabling ID to the RF chip, the enabling ID uniquely identifying the customer device to the RF chip (540), the RF chip configured to transmit the RF signal to the customer device via the first communications path (Fig. 5A - interrogator kiosk

Art Unit: 2876

communicates with mobile device via RFID), receive the enabling ID from the RF chip and store the enabling ID (ID is at least temporarily stored in order to pass to the host - 540, 545), and means for causing an entity associated with the RF chip (merchant) to be financially compensated by a communication provider (1407, 1595) associated with the communication network (Fig. 14) for the network communications (network communications includes transaction information and the merchant is compensated by the payment system for the transaction) of the customer device triggered by the RF chip, based at least in part on the enabling ID (ID used to access payment account).

Regarding claims 7 and 18, Pond teaches a system comprising: a customer device (502) configured to receive an RF signal and an enabling ID from an RF chip (104) via a first communication path (540) and responsively start communicating with a communication network via a second separate communication path (1409, 545), the RF chip comprising means for sending the enabling ID to the customer device (Fig. 2A, 545), the enabling ID uniquely identifying the RF chip to the customer device [0088], and means for causing an entity (merchant) associated with the RF chip to be financially compensated by a communication provider (1407, 1595) associated with the communication network (Fig. 14) for the network communications (network communications includes transaction information and the merchant is compensated by the payment system for the transaction) of the customer device triggered by the RF chip, based at least in part on the enabling ID (ID used to access payment account).

Regarding claims 8 and 19, Pond teaches wherein the customer device comprises a memory (382) for storing the enabling ID (ID is stored in order to to pass to

Art Unit: 2876

host - 545) and the customer device comprises means for reading the enabling ID from the memory and transmitting the enabling ID for use in financially compensating the entity (545).

Regarding claims 11, 17, and 22, Pond teaches wherein billing information is created based on the enabling ID [0088].

Regarding claim 13, Pond teaches wherein the method further comprises the step of reading the enabling ID from the memory and transmitting the ID for use in financially compensating the entity (ID must be temporarily stored in the memory of 502 in order to pass to host – 540, 545).

Regarding claims 23, 24, 25, and 26, Pond teaches wherein the RF signal transmitted from the RF chip to the customer device (510, 520, 530) contains an identifier (URL) identifying the communication network of the communication provider and the customer device uses the identifier to connect to the communication network [0088].

Regarding claims 27 and 28, Pond teaches wherein a user of the customer device pays the communication provider for access to the communication network (user pays credit card bills to payment system 1407 – [0133]) and the compensation to the first entity rewards the first entity for causing the customer device to use the communication network (1550 – [0150] [0151]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2876

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5, 9, 16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pond in view of Elston et al. (US 2003/0191709 A1). The teachings of Pond have been discussed above.

Regarding claims 5, 9, 16, and 20, Pond teaches the system and methods of claims 1, 8, 13, and 19.

Pond lacks clearing the memory of the enabling ID.

Elston teaches means to clear the memory of the enabling ID [0168].

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to clear the memory of the enabling ID because the enabling ID may be sensitive information (such as account number, PIN number, one-time password, etc.) and storing this information at all times may compromise the security of the account associated with the information.

Response to Arguments

Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection. New grounds of rejection are in view of Pond and are required by the amendments to the independent claims regarding the relationships between the RF chip and the customer device.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAFFERTY KELLY whose telephone number is (571)270-5031. The examiner can normally be reached on Mon. - Fri. 800-1730 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rafferty Kelly/
Examiner, Art Unit 2876
1-14-11

/Michael G Lee/
Supervisory Patent Examiner, Art Unit 2876